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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : PISHEVAR et al. Group Art Unit: 3624
Serial No : 09/326,646 Examiner: KYLE, Charles R.
Filed : June 7, 1999 Conf. No.: 4448
For : COLLECTIVE PROCUREMENT MANAGEMENT SYSTEM

APPEAL BRIEF

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COMMISSIONER FOR PATENTS
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Sir:

This Appeal Brief is being submitted after the two-month period set by 37 C.F.R. §41.37(a)(1) but within seven months of the date of the Notice of Appeal filed on March 8, 2005. Accordingly, a five-month extension of time is respectfully requested. Entry and consideration of this Appeal Brief pursuant to 37 C.F.R. §§41.37(e), 1.136(a) and 1.7(a) are earnestly solicited.

(i) Real Party in Interest

Pursuant to an Assignment included herewith, as executed on June 7, 1999, but which remains unfiled in the U.S. Patent and Trademark Office, the present assignee is Hyperoffice.com, Inc., a corporation now having a place of business at 2230 Gallows Road #330, Vienna, Virginia 22027. However, pursuant to an agreement executed on or about June 3, 2005 between Hyperoffice.com, Inc. and Freewebs Corporation, a Delaware Corporation having

a place of business at 1320 Fenwick Lane, Suite 206, Silver Spring, MD 20910, this application is to be assigned to Freewebs Corporation. A copy of this agreement remains unavailable as of the date of this filing. However, Freewebs Corporation is submitted and identified to be the real party of interest.

(ii) Related Appeals and Interferences

There are no related appeals or interferences.

(iii) Status of Claims

Claims 2-11, 13-17, 19, 36-40, 42 and 44 are currently pending in this application. Claims 2, 10 and 36 are independent. All pending claims stand rejected under 35 U.S.C. §112, first paragraph.

(iv) Status of Amendments

No Amendments to the claims were submitted after the most recent Final Rejection dated September 8, 2004. A Response to Final Rejection containing arguments only was submitted on December 8, 2004 and was acknowledged by the Examiner in an Advisory Action dated January 12, 2005.

(v) Summary of Claimed Subject Matter

Independent claims 2, 10, and 36 respectively recite a system, method and apparatus for fulfilling a collective procurement order between at least one supplier and a plurality of

purchasers, in which a profile is generated for each of the plurality of purchasers based on their purchasing characteristics over a period of time, including types of items ordered, quantities of items ordered, location and shipping needs. A profile is also generated for each of the plurality of sellers based on types of items provided, industry type, payment methods used, order shipment time and credit rating. Each of the sellers is provided a macro for automatically uploading a catalog of items available for purchase, including a minimum price and a minimum order size of each of the items, which information may be communicated to interested purchasers. A plurality of purchasers may then submit a purchase request collectively regarding an identified item, the purchase request including at least one separate purchase price, a separate quantity of the identified item, and a separate delivery condition for the identified item corresponding to each of the purchasers. The plurality of suppliers may submit a bid for a supply commitment for the item identified in the purchase request, where each bid may include a plurality of supply prices for the identified item, each supply price corresponding to a quantity of the identified item to be included in a purchase order. At least one of the plurality of sellers is then determined based on the received bids, and a final supply price for the collective procurement order is determined based on the quantity of the identified item in the collective procurement order and the received bids from the suppliers. The collective procurement purchase order is then fulfilled by matching at least one of the identified suppliers to at least one of said plurality of purchasers, based on a comparison of the profile of each purchaser with the profile of each identified supplier, and further based on each requested purchase price and received delivery condition compared to the supply commitment received for each identified supplier. At least one of the purchase requests

are fulfilled at the final supply price when the final supply price is lower than the purchase price included in said purchase request.

(vi) Grounds of Rejection to be Reviewed on Appeal

Each of the pending claims stand rejected only under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

(vii) Argument

The Examiner has rejected each of pending claims 2-11, 13-17, 19, 36-40, 42 and 44 under 35 U.S.C. §112, first paragraph, as “failing to comply with the written description requirement.” Applicants respectfully disagree. Applicants argue the pending claims as one group, since the contested recitations appear in each claim, either directly or via their dependency of one of the independent claims.

In a Response to the Office Action dated June 1, 2004, Applicant provided the Examiner with citations in the Specification in which each of the amended recitations of the claims is readily supported, namely, p. 14, lines 1-9; p. 24, lines 17-19; and p. 26, line 14- page 27, line 25. Additional support can be found in the matching steps of FIGS. 3 and 4 of the application.

Instead of alleging a failure of the recitations to be described in the Specification, the Examiner instead argues that the “specification provides no information as to what methods, algorithms or systems are used to perform the comparison...” of customer and merchant profiles based on comparison keys of customer and merchant profiles recited in the claims. The

Examiner further states that “[n]o information is provided as to what statistical or inferential methods are used by the invention.”

In response to these and other arguments put forth by the Examiner, Applicants assert that various manners for the profiling and comparison of customers and merchants are well known in the art, any of which may be used in accordance with applicants’ claimed methods and apparatus. The invention is not limited to any one particular set of matching algorithms for accomplishing this, either in the claims or the Specification, but may instead rely on any of a variety of existing or later developed matching algorithms that incorporate the profile information for purchasers and sellers.

“A patent need not teach, and preferably omits, what is well known in the art.” MPEP §2164.01. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

“The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification.” MPEP §2164.03. “A single embodiment may provide broad enablement in cases involving predictable factors, such as mechanical or electrical elements.” *In re Vickers*, 141 F.2d 522, 526-27, 61 USPQ 122, 127 (CCPA 1944); *In re Cook*, 439 F.2d 730, 734, 169 USPQ 298, 301 (CCPA 1971). Applicants have provided a description of such broad embodiments in the Specification at pp. 25-27.

“Applicant may ... cite references to show what one skilled in the art knew at the time of filing the application.” MPEP §2164.05. Applicants direct the Board’s attention to patents such as U.S. Patent Nos. 6,035,288; 6,343,274; 5, 664,115 and 5,592,375, each of which predate Applicants filing date, and which disclose various methods for profiling customers and merchants in various contexts. These references establish that various methods for accomplishing the matching of customer and merchant profile were sufficiently well known in the prior art. The Applicants’ disclosure is therefore sufficient to convey to one of ordinary skill in the art how to use customer and merchant profiling information as recited, due to its reliance of the knowledge of those skilled in the art .

“The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims.” MPEP §2163.04 . *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. In support of these rejections, the Examiner states “the comparison keys recited for buyers and sellers differ and it is unclear how comparison of unlike keys would be performed.” However, there is no requirement in the claims or specification that each of the elements of a comparison key of a merchant be matched with an element of a comparison key of the consumer, or the reverse. That is, while each claim recites what profile information may be collected for a consumer and for a merchant, there is no requirement in the claims or Specification that each item of profile information relating to a purchaser must match with an item of profile information for a seller. The Examiner has chosen to read in such a limitation without cause or explanation.

One of ordinary skill in the art will readily recognize from a review of the Specification that there may be no comparison of unlike information, and conversely, that there may be a comparison of like information. For example, one of ordinary skill in the art will readily appreciate that the recited “order shipment time” for a merchant profile may be compared to the “shipping needs” recited for the customer profile. One of ordinary skill in the art will further recognize that order shipment time may be based on the location of the consumer. Other combinations of comparison key information are likewise readily apparent. Accordingly, one of ordinary skill in the art will readily understand from Applicants’ Specification at, inter alia, pp. 25-27, and the level of knowledge in the prior art, how to compare consumer and merchant profile information.

In the Advisory Action dated January 12, 2005, the Examiner was not convinced by the arguments provided above and instead asserted that Applicants have provided “no substantive argument” to overcome the final rejection. The Examiner went on to reassert that “Applicants Specification at page 27 recites ‘the profiling system becomes more intelligent over time.’, but gives no suggestion as to how this is accomplished.” Applicants note that the ability to become “more intelligent” is not a feature recited in the claims. In addition, however, Applicants assert that it is readily apparent to one of ordinary skill in the art, from careful reading of the Specification, that the inventive system becomes more intelligent over time as more information is collected about the purchasing information of purchasers and the ability of sellers to fulfill purchase orders.

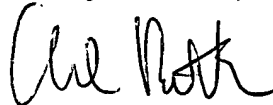
In the Advisory Action of January 12, 2005, the Examiner seems to assert that the present application must conform to the standard of U.S. Patent 6,098,051 with respect to the level of

detail it provides about the algorithms used by a system. Applicants' are not aware of any such requirement in the Patent Laws, nor is the Applicants' invention particularly limited to any one type of matching algorithm. Accordingly, Applicant again asserts that the written description has been met for the reasons provided above, namely that the claim recitations are readily supported by the Specification and that the Specification, comprising some 30 pages of disclosure, in conjunction with the level of knowledge demonstrated in the prior art (notably in the patents referenced by the Applicants above, as well as U.S. Patent No. 6,098,051 referenced by the Examiner), will be readily appreciated by one of ordinary skill in the art as descriptive of how to implement such a system.

Applicants affirm that the prior art of record fails to disclose a procurement system as recited in the claims in which customer and merchant profiling information may be used to match buyers and sellers in the collective procurement processes recited, that the disclosure of the invention is sufficient for one of ordinary skill in the art to understand the invention, and that Applicants had sufficient possession of the claimed invention at the time of filing of the present application. Accordingly, Applicants request that the Board overturn the rejection of all pending claims under 35 U.S.C. §112, first paragraph for the reasons provided herein.

Respectfully submitted,

By:



Charles A. Rattner
Registration No. 40,136
12 Homewood Lane
Darien, CT 06820-6109
(203) 325-8240
(203) 547-6129 (facsimile)
crattner@axiomlegal.net

Dated: October 11, 2005

(viii) Claims Appendix

The following are the claims involved in the appeal:

Claim 1. (canceled)

Claim 2. A collective procurement management system comprising:

a processor; and

a memory in communication with the processor, the memory storing a plurality of processing instructions that enable the processor to:

generate a profile for each of a plurality of purchasers based on their purchasing characteristics over a period of time, the profile characteristics including types of items ordered, quantities of items ordered, location and shipping needs;

generate a profile for each of a plurality of sellers based on types of items provided, industry type, payment methods used, order shipment time and credit rating;

provide to each of the plurality of sellers a macro for automatically uploading a catalog of items available for purchase, including a minimum price and a minimum order size of each of the items;

provide the minimum price and the minimum order size to the plurality of purchasers prior to a submission of a purchase request;

receive a purchase request from each of the plurality of purchasers for an item, each purchase request including a at least one separate purchase price for the item, a separate quantity of the item, and a separate delivery condition for the item;

receive, from each of a plurality of sellers, a bid for a supply commitment for the item, each bid including a plurality of supply prices for the item, each supply price corresponding to a quantity of the item to be included in an order;

group said plurality of purchase requests, based on the item and the purchase price, into a collective procurement order;

identify at least one of the plurality of sellers for supplying the item for the collective procurement order based on the received bids;

identify a final supply price for the collective procurement order based on the ordered quantity of the item in the collective procurement order and the received bids; and

fulfill said collective procurement order by matching at least one of the identified suppliers at least one of said plurality of purchasers, based on a comparison of the profile of each purchaser with the with the profile of each identified supplier, and further based on each requested purchase price and received delivery condition compared to the supply commitment received for each identified supplier, at least one of said purchase requests being fulfilled at the final supply price when the final supply price is lower than the purchase price included in said purchase request.

Claim 3. The system of claim 2, said memory further comprising an inventory database including a listing of at least one item available for purchase by the plurality of purchasers.

Claim 4. The system of claim 2 wherein the processor groups each purchase request based on a similar item requested by the plurality of purchasers.

Claim 5. The system of claim 2 wherein the processor groups each purchase request only if the purchase requests specify the same item.

Claim 6. The system of claim 2 wherein the processor fulfills the collective procurement order if the plurality of purchase requests satisfy at least one threshold condition.

Claim 7. The system of claim 6, said threshold condition including a minimum number of purchasers in the collective procurement order.

Claim 8. The system of claim 6, said threshold condition including a minimum quantity of requested items in the collective procurement order.

Claim 9. The system of claim 6, said threshold condition including a minimum total order price for the collective procurement order, the total order price based on the plurality of purchase prices and a number of requested items in the collective procurement order.

Claim 10. A method for fulfilling a collective procurement order between at least one supplier and a plurality of purchasers, the method comprising:

generating a profile for each of a plurality of purchasers based on their purchasing characteristics over a period of time, the profile characteristics including types of items ordered, quantities of items ordered, location and shipping needs;

generating a profile for each of a plurality of sellers based on types of items provided, industry type, payment methods used, order shipment time and credit rating;

providing to each of the plurality of sellers a macro for automatically uploading a catalog of items available for purchase, including a minimum price and a minimum order size of each of the items;

providing the minimum price and the minimum order size to the plurality of purchasers prior to a submission of a purchase request;

receiving a purchase request from each of a plurality of purchasers for an identified item, the purchase request including at least one separate purchase price, a separate quantity of the identified item, and a separate delivery condition for the identified item;

receiving, from each of a plurality of sellers, a bid for a supply commitment for the identified item, each bid including a plurality of supply prices for the identified item, each supply price corresponding to a quantity of the identified item to be included in an order;

grouping said plurality of purchase requests, based on the identified item and the purchase price, into a collective procurement order;

identifying at least one of the plurality of sellers for supplying the identified item for the collective procurement order, based on the received bids;

identifying a final supply price for the collective procurement order based on the quantity of the identified item in the collective procurement order and the received bids; and

fulfilling said collective procurement order by matching at least one of the identified suppliers to at least one of said plurality of purchasers, based on a comparison of the profile of each purchaser with the with the profile of each identified supplier, and further based

on each requested purchase price and received delivery condition compared to the supply commitment received for each identified supplier, at least one of said purchase requests being fulfilled at the final supply price when the final supply price is lower than the purchase price included in said purchase request.

Claim 11. The method of claim 10 wherein each of said suppliers fulfill at least a portion of each purchase request.

Claim 12. (canceled)

Claim 13. The method of claim 10, said fulfilling further comprising:

fulfilling the collective procurement order only if a minimum total quantity of the identified item is ordered from the plurality of purchase requests.

Claim 14. The method of claim 10, said fulfilling further comprising:

fulfilling said collective procurement order only if a minimum number of purchasers are grouped.

Claim 15. The method of claim 10, said fulfilling further comprising:

fulfilling the collective procurement order only if a minimum total order price is established for the collective procurement order, based on the plurality of purchase requests.

Claim 16. The method of claim 10 wherein said purchase price received from each of said purchasers includes a plurality of prices, each price corresponding to different quantities of the identified item in the purchase request.

Claim 17. The method of claim 10, further comprising:
receiving at least one acceptable price from the at least one supplier, each acceptable price corresponding to a total quantity of the identified item in the collective procurement order.

Claim 18. (canceled)

Claim 19. The method of claim 10, each said purchase request specifying at least one additional purchase condition in connection with the identified item.

Claims 20-35. (canceled)

Claim 36. An apparatus for completing collective procurement management orders, comprising:

means for generating a profile for each of a plurality of purchasers based on their purchasing characteristics over a period of time, the profile characteristics including types of items ordered, quantities of items ordered, location and shipping needs;

means for generating a profile for each of a plurality of sellers based on types of items provided, industry type, payment methods used, order shipment time and credit rating;

means for providing to each of the plurality of sellers a macro for automatically uploading a catalog of items available for purchase, including a minimum price and a minimum order size of each of the items;

means for providing the minimum price and the minimum order size to the plurality of purchasers prior to a submission of a purchase request;

means for receiving a purchase request from each of a plurality of purchasers for an identified item, the purchase request including at least one separate purchase price, a separate quantity of the identified item, and a separate delivery condition for the identified item;

means for receiving, from each of a plurality of sellers, a bid for a supply commitment for the identified item, each bid including a plurality of supply prices for the identified item, each supply price corresponding to a quantity of the identified item to be included in an order;

means for grouping said plurality of purchase requests, based on the identified item and the purchase price, into a collective procurement order;

means for identifying at least one of the plurality of sellers for supplying the identified item for the collective procurement order, based on the received bids;

means for identifying a final supply price for the collective procurement order based on the quantity of the identified item in the collective procurement order and the received bids; and

means for fulfilling said collective procurement order by matching at least one of the identified suppliers to at least one of said plurality of purchasers, based on a comparison of the profile of each purchaser with the with the profile of each identified supplier, and further based on each requested purchase price and received delivery condition compared to the supply commitment received for each identified supplier, at least one of said purchase requests being fulfilled at the final supply price when the final supply price is lower than the purchase price included in said purchase request.

Claim 37. The apparatus of claim 36, said purchase request including at least one additional purchase criteria.

Claim 38. The apparatus of claim 36, further comprising:

means for notifying at least one purchaser of a pending collective procurement order based upon profile information of the purchaser.

Claim 39. The apparatus of claim 36, further comprising:

means for identifying, to the at least one supplier, a number of purchase requests forming said collective procurement order, wherein said supply price is based on the number of purchase requests.

Claim 40. The apparatus of claim 36, further comprising:

means for notifying the plurality of purchasers of an amount of time remaining prior to a closing of the collective procurement order.

Claim 41. (canceled)

Claim 42. The system of claim 2, said plurality of purchasers comprising at least two purchasers providing different purchase prices.

Claim 43. (canceled)

Claim 44. The method of claim 10, said plurality of purchasers comprising at least two purchasers providing different purchase prices.

Claim 45. (canceled)

(ix) Evidence Appendix

A copy of the Assignment between Applicants and Hyperoffice.com, Inc., as referenced in the section entitled “Real Party in Interest” follows this page:

ASSIGNMENT

WHEREAS, We, Shervin PISHEVAR, a citizen of the United States, residing at 46 Federal Court, Gaithersburg, Maryland 20877, and Drew E. MORRIS, a citizen of the United States, residing at 23 Timberline Drive, Alpine, New Jersey 07620, ("the Assignors") have made an invention entitled

COLLECTIVE PROCUREMENT MANAGEMENT SYSTEM

described in the application for United States Letters Patent filed on June 7, 1999; and

WHEREAS, HYPEROFFICE.COM, Inc. (the "Assignee"), a corporation having a place of business at 326 North Charles Street, Suite 301, Baltimore, Maryland 21201 is desirous of acquiring the entire right, title and interest in and to the aforesaid invention in and to the application and all Letters Patent of the United States or any foreign country, including continuations, continuations-in-part, reissues, reexaminations, extensions, substitutes and divisions which may be granted therefor;

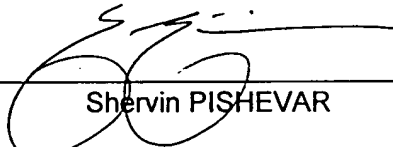
NOW THEREFORE, in consideration of the sum of One Dollar (\$1.00) and other good and valuable consideration, the receipt of which is hereby acknowledged, we, the said Assignors, by these presents do sell, assign, set over and transfer unto Assignee, its successors, legal representatives and assigns, the full and exclusive right in and to the said invention as described in the said application, and in and to any Letters Patent of the United States or any foreign country, including continuations, continuations-in-part, reissue, reexaminations, extensions, substitutes and divisions which may be granted therefor and all rights to claim priority on the basis of said application;

AND WE HEREBY authorize and request the Commissioner of Patents and Trademarks or any other proper officer or agency of any country to issue all said Letters Patent to said Assignee;

AND WE HEREBY warrant and covenant that we have the full right to convey the entire interest herein assigned and that we have not executed and will not execute any instrument or assignment in conflict herewith;

AND WE HEREBY agree to communicate to said Assignee or its representatives any facts known to us respecting said invention, to execute all divisional, continuation, continuation-in-part, reissue, reexamination, extension, substitute and foreign applications, sign all lawful documents and make all rightful oaths and declarations relating to said inventions, execute and deliver any and all papers that may be necessary or desirable to perfect the title to this invention in said assignee, its successors, legal representatives or assigns, and to testify in any judicial or administrative proceeding and generally do everything possible to aid the said Assignee to obtain and enforce said Letters Patent in the United States or any foreign country when requested so to do by said Assignee.

Signature of Inventor:
Inventor's Name:

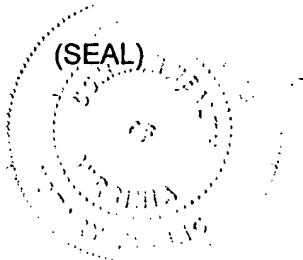

Shervin PISHEVAR
JUNE 7, 1999

Date of Execution:

IN WITNESS WHEREOF, I have hereunto set my hand and seal.

COUNTY OF Fairfax)
STATE OF Virginia) ss:

On this 7th day of June, 1999, before me a Notary Public in and for the County and State aforesaid, personally appeared Shervin PISHEVAR, to me known and known to me to be the person of that name, who signed and sealed the foregoing instrument, and acknowledged the same to be of his free act and deed.




Notary Public

My commission Expires: 1/31/2002

Signature of Inventor:
Inventor's Name:


Drew E. Morris

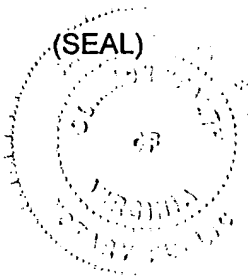
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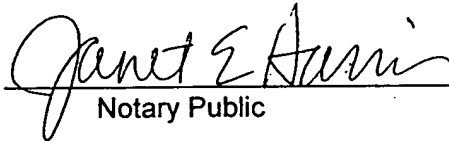
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IN WITNESS WHEREOF, I have hereunto set my hand and seal.

COUNTY OF Fairfax)
STATE OF Virginia) ss:

On this 7th day of June, 1999, before me a Notary Public in and for the County and State aforesaid, personally appeared Drew E. Morris, to me known and known to me to be the person of that name, who signed and sealed the foregoing instrument, and acknowledged the same to be of his free act and deed.




Notary Public

My commission Expires: 1/31/2002

(x) Related Proceeding Appendix

There are no separate proceedings related to this Appeal.